



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,239	12/09/2003	Kevin L. Bostrom	LUC-442/Bostrom 5-6-11	4882

32205 7590 12/18/2006
CARMEN B. PATTI & ASSOCIATES, LLC
ONE NORTH LASALLE STREET
44TH FLOOR
CHICAGO, IL 60602

EXAMINER

LEE, JOHN J

ART UNIT	PAPER NUMBER
----------	--------------

2618

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/18/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/731,239	Applicant(s) BOSTROM ET AL.	
	Examiner JOHN J. LEE	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,10-12,14,15,19 and 20 is/are rejected.
- 7) ☒ Claim(s) 4,6-9,13 and 16-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/23/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-3, 5, 10-12, 14, 15, 19 and 20** are rejected under 35 U.S.C. 102(b) as being anticipated by Adamek et al. (US 2002/0176559).

Regarding **claim 1**, Adamek teaches that one or more video server components (multimedia communications system in Fig. 1) that play one or more videos (playing the multimedia, video/audio) at one or more mobile phones (102 in Fig. 1) while one or more phone calls associated with the one or more mobile phones are on hold (page 1, paragraphs 5 – 11 and Fig. 1, where teaches supplying multimedia data by multimedia providing networks to callers (mobile terminals) whose interactive calls (voice calls, video calls) are placed on hold, and while on hold, a multimedia communication is sent to user terminal, and an invitation is sent to the user terminal to accept the multimedia communication while on hold).

Regarding **claim 2**, Adamek teaches that the one or more video server components (multimedia communications system in Fig. 1) that play the one or more videos at the one or more mobile phones (102 in Fig. 1) comprise a video server component that plays a video for a mobile phone (the multimedia providers provide the multimedia, video/audio, to the wireless terminal), wherein the video server component

sends a query message to the mobile phone for permission to send the video to the mobile phone (page 1, paragraphs 5 – 11 and Fig. 1, where teaches supplying multimedia data by multimedia providing networks to callers (mobile terminals) whose interactive calls (voice calls, video calls) are placed on hold, and while on hold, a multimedia communication is sent to user terminal, and an invitation (query message) is sent to the user terminal to accept (permission) the multimedia communication while on hold).

Regarding **claim 3**, Adamek teaches that the query message (invitation) comprises an internet protocol address for connection to the video (pages 2, paragraphs 18 – 21 and Fig. 2, where teaches the setup multimedia services are provided over the bearer paths to the user that awaits the destination (IP address cause using the connection to IP network)), wherein the mobile phone replies to the video server component with permission to play the video (pages 2, paragraphs 18 – 21 and Fig. 2, where teaches the user terminal sends to the multimedia network with acceptance to play multimedia), wherein the video server component connects the mobile phone with the internet protocol address to play the video at the mobile phone (pages 2, paragraphs 18 – pages 3, paragraphs 23 and Fig. 2, where teaches the multimedia network establishes the session setup to the user terminal with IP address and providing the multimedia to play at the user terminal).

Regarding **claim 5**, Adamek teaches that the one or more video server components (multimedia communications system in Fig. 1) that play the one or more videos at the one or more mobile phones while the one or more phone calls associated with the one or more mobile phones are on hold comprise a video server component that

plays a video for a mobile phone while a phone call associated with the mobile phone is on hold (page 1, paragraphs 5, Fig. 1, 2, and pages 2, paragraphs 17 – 21, where teaches supplying multimedia data by multimedia providing networks to callers (mobile terminals) whose interactive calls (voice calls, video calls) are placed on hold, and while on hold, a multimedia communication is sent to user terminal, and an invitation is sent to the user terminal to accept the multimedia communication while on hold). Adamek teaches that the interactive server component connects with the phone call associated with the mobile phone through a voice network (public telephone network) component (Fig. 1 and page 1, paragraphs 8 – pages 2, paragraphs 16, where teaches the multimedia network couples with the phone call associated with public telephone network). Adamek teaches that the interactive server component places the phone call associated with the mobile phone on hold (page 1, paragraphs 5, Fig. 1, 2, and pages 2, paragraphs 17 – 21, where teaches supplying multimedia data by multimedia providing networks to callers (mobile terminals) whose interactive calls (voice calls, video calls) are placed on hold, and while on hold, a multimedia communication is sent to user terminal, and an invitation is sent to the user terminal to accept the multimedia communication while on hold).

Regarding **claim 10**, Adamek teaches that the video server component or the interactive server component sends a query message to the mobile phone for permission to play the video at the mobile phone (page 1, paragraphs 5 – 11 and Fig. 1, where teaches supplying multimedia data by multimedia providing networks to callers (mobile terminals) whose interactive calls (voice calls, video calls) are placed on hold, and while on hold, a multimedia communication is sent to user terminal, and an invitation (query

Art Unit: 2618

message) is sent to the user terminal to accept (permission) the multimedia communication while on hold).

Regarding **claim 11**, Adamek teaches all the limitation, as discussed in claims 3 and 5. Furthermore, Adamek teaches that the video server component connects the mobile phone to the video at the internet protocol address through a data network (Fig. 1 and page 1, paragraphs 8 – pages 2, paragraphs 16, where teaches the multimedia network couples the wireless terminal to the multimedia at IP address (destination) with data network, GPRS, GGSN).

Regarding **claim 12**, Adamek teaches all the limitation, as discussed in claims 5 and 11.

Regarding **claims 14 and 20**, Adamek teaches all the limitation, as discussed in claims 1 and 5.

Regarding **claim 15**, Adamek teaches all the limitation, as discussed in claims 2 and 5.

Regarding **claim 19**, Adamek teaches that ending a transmission of one or more of the one or more videos at one or more of the one or more mobile phones (pages 2, paragraphs 18 – pages 3, paragraphs 23 and Fig. 2, where teaches the user awaiting the destination has the option to end the multimedia session). Adamek teaches that taking one or more of the one or more phone calls associated with the one or more of the one or more mobile phones off hold (pages 2, paragraphs 18 – pages 3, paragraphs 23 and Fig. 2).

Allowable Subject Matter

3. Claims 4, 6-9, 13, and 16-18 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to disclose “the query message comprises a choice between the first video and a second video, wherein the first video is stored at the first internet protocol address and the second video is stored at a second internet protocol address, and a user of the mobile phone employs the mobile phone to reply to the choice with a selection of the first video or the second video, wherein the mobile phone sends the selection to the video server component, and wherein the video server component employs the selection to connect the mobile phone to the first internet protocol address for the first video or the second internet protocol address for the second video, and also the interactive server component searches a database with the user information to make a determination of one or more user preferences of a user of the mobile phone, and the interactive server component passes the one or more user preferences to the video server component” as specified in the above the claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2618

Boies et al. (US 2002/0191775) discloses Personalizing Content Presented While Waiting.

Boies et al. (US 2002/0194011) discloses Computer Program Product for Selecting a Format for Presenting Information Content Based on Limitations of a User.

Sand et al. (US 2004/0266410) discloses Legal Intercept Monitoring of a Cellular Telephone Modem Device.

Information regarding...Patent Application Information Retrieval (PAIR) system... at 866-217-9197 (toll-free)."

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231
Or P.O. Box 1450
Alexandria VA 22313

or faxed (571) 273-8300, (for formal communications intended for entry)

Or: (703) 308-6606 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to USPTO Headquarters, Alexandria, VA.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John J. Lee** whose telephone number is **(571) 272-7880**. He can normally be reached Monday-Thursday and alternate Fridays from 8:30am-5:00 pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, **Edward Urban**, can be reached on **(571) 272-7899**. Any inquiry of a general nature or


Art Unit: 2618

relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

J.L

December 9, 2006

John J Lee


EDWARD E. MATTAN
SUPERVISOR, TECHNICAL
TECHNOLOGY CENTER